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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,649	04/06/2001	Scot A. Reader		5707

7590
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10/12/2005

EXAMINER

ROBINSON, GRETA LEE

ART UNIT PAPER NUMBER

2168

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/828,649	READER, SCOT A.	
	Examiner	Art Unit	
	Greta L. Robinson	2177	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/5/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-36 are pending in the present application.
2. Claims 1, 7, 11, 23, 25 and 27 were amended in a preliminary amendment filed September 19, 2001; and claims 28-36 were added in a second preliminary amendment filed January 10, 2002.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on June 5, 2002 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

4. The drawings are objected to because of improper numbering of the figures. Note Figure 2 contains two views and should therefore be labeled separately, also note Figure 4. See 37 CFR 1.84(u) regarding numbering of views. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary,

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the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The amendment filed September 29, 2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

"non-transparent" and "not transparent" [note: abstract; page 1, page 4, page 9, and claim 23].

Applicant is required to cancel the new matter in the reply to this Office Action.

6. A substitute specification excluding the claims is required pursuant to 37 CFR 1.125(a) because of the number and nature of the amendment.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the

immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 23-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "not transparent" is not supported in the original disclosure. Applicant notes in the remarks section of the preliminary amendment filed September 19, 2001 that the use of the term "transparent"

as opposed to “non-transparent” was an error. Applicant states that because the error was obvious, it is not new matter. Applicant must cite specific support for the amendment. Also Applicant states the “more complete description clearly explains that the subject search client actions are unseen by, that is, non-transparent to the user” [see page 11 lines 1-2 of response filed September 19, 2001]. The examiner notes the standard definition of transparent as cited in Microsoft Computer Dictionary fifth edition page 528 as follows: In computer use, of, pertaining to, or characteristics of a device, function, or part of a program that works so smoothly and easily that it is invisible to the user. For example, the ability of one application program to use files created by another is transparent if the user encounters no difficulty in opening, reading, or using the second program’s files or does not even know the use is occurring.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 7-10 and 28-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 7, the following limitation is vague: attribute-related patents [see: claim 7 line 2]. Claims 8-10 are rejected based on dependency.

Regarding claim 28, the following limitation is vague: “patent-relevant documents” [note: claim 28 line 1]; and “at least part of a search term” [see claim 28 line 8]. Claims 29-32 are rejected based on dependency.

Regarding claim 33, the following limitation is vague Internet publication relevant [note: claim 33 line 1]. Claims 34-36 are rejected based on dependency.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-22 and 28-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee US Patent 6,694,331 B2.

Regarding claim 1, **Lee** teaches a method of finding documents published on the Internet [note: abstract; column 12 lines 42-50], comprising the steps of:

inputting a patent-identifying attribute on an end-user station [note: Figure 3; column 12 lines 63-65];

identifying patent data from a first search using the patent-identifying attribute [note: Figure 3; Figure 5 step 706 identify search information];

identifying Internet publication data from a second search using the patent data [note: Figures 3 and 5]; and

outputting the Internet publication data on the end-user station [note: Figure 3 element 510 display results],

wherein the last three steps are performed automatically in response to the first step [note: column 3 lines 35 through column 4 line 65; column 8 lines 29-45].

13. Regarding claims 2-6:

(claim 2) wherein the patent data are abstracted prior to identifying the Internet publication [note: column 4 lines 8-29].

(claims 3-5) wherein the sole patent-identifying attribute is an assignee ... inventor name ... patent number [note: column 8 lines 11-20; also note Figure 2].

(claim 6) wherein the Internet publication data include a Uniform resource Locator (URL) [note: column 5 lines 33-55].

14. The limitations of claims 7-22 have been addressed above except for the following: searching a first database using the patent-identifying attribute ... searching a second database using the patent data to locate web document data [note: abstract; column 2 lines 40-57; column 7 line 53 through column 8 line 7; Figure 1 note database 32, 38 and 39].

15. Regarding claims 28-32, a finding patent-relevant documents published on the Internet ... inputting a patent-identifying attribute ... identify a search term and a search context from a first database ... a company website identifier from a second database

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... outputting the Internet publication identifier on the end-user station [note: column 7 lines 10-25 and lines 53-67; column 8 lines 11-67].

16. The limitations of claims 33-36 parallel that of claims 28-32; therefore they are rejected under the same rationale.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Arthurs US Patent 6,591,261 B1

De La Huerga US Patent 6,507,837 B1

Nosohara US Patent 6,571,241 B1

Unger et al. US Patent 5,721,910

Lee US Patent 6,662,178 B2

STNews November/December 1998

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (703) 308-7565. The examiner can normally be reached on Mon.-Fri. 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



GRETA ROBINSON
PRIMARY EXAMINER

Greta Robinson
Primary Examiner
August 27, 2004